

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Hearing:
September 28, 2005

Mailed:
January 17, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

D.K. Agencies (P) Ltd.

v.

Dorling Kindersley Limited

Cancellation Nos. 92041796 and 92041803

Thomas M. Galgano of Galgano & Burke, LLP for D.K. Agencies
(P) Ltd.

James E. Doherty of Eisenberg Tanchum & Levy for Dorling
Kindersley Limited

Before Seeherman, Hohein and Walters, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

On March 5, 2003, D.K. Agencies (P) Ltd., an Indian company, filed petitions to cancel two registrations owned by Dorling Kindersley Limited on the ground of priority of use and likelihood of confusion. The registrations, Nos. 1763689 and 2037282 are both for the mark DK superimposed on an open book design, for goods identified, respectively, as printed publications namely, oversize or folio books on a

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variety of non-fiction topics; and videotapes, compact discs, computer software and audiotapes featuring a wide variety of specified subjects.

Because the proceedings involve common questions of law and fact, after answers were filed the Board consolidated the proceedings. The answers denied petitioner's allegations of priority and likelihood of confusion, and raised numerous affirmative defenses, including estoppel, laches and acquiescence, and that respondent's registrations had attained or were in the process of attaining incontestable status through respondent's filing, and in the case of Registration No. 1763689, the Office's acceptance, of respondent's Section 8 and 15 affidavits.

The parties stipulated to the admission of testimony in the form of declarations, and the testimony of numerous witnesses was submitted in this manner.

The proceeding has been fully briefed. Only respondent appeared at an oral hearing held before the Board.

A review of respondent's registrations, which are automatically of record pursuant to Trademark Rule 2.122(b), shows that Registration No. 1763689 issued on the Principal Register on April 6, 1993, and that Registration No. 2037282 issued on the Principal Register on February 11, 1997. Section 14(1) of the Trademark Act, 15 U.S.C. §1064(1), provides that a petition to cancel a registration of a mark

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on the Principal Register must be filed "within five years from the date of the registration of the mark under this Act." Petitioner filed the petitions to cancel both registrations on March 5, 2003, almost ten years after the issuance of Registration No. 1763689 and almost six years after the issuance of Registration No. 2037282. Accordingly, petitioner has no legal right to file a petition to cancel these registrations on the ground of likelihood of confusion.¹

We note that respondent has couched its argument that the proceeding should be dismissed in terms of the incontestability of its registrations. In fact, incontestability is a defense in civil litigation, not in Board proceedings. As noted above, the appropriate statutory reference is Section 14(1) of the Act, which sets forth the time periods in which a petition for cancellation may be brought.

In response to respondent's arguments that petitioner's petitions are untimely, petitioner asserts, in its reply brief, that Section 1065 of the Act provides an exception to incontestability. Again, the operative statutory provision

¹ Petitions to cancel trademark registrations issued under this Act may be brought "at any time" based on certain grounds enumerated in Section 14(3), but likelihood of confusion (Section 2(d) of the Act), is not one of them.

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is Section 14(1), and incontestability or exceptions to incontestability have no bearing on it.

Petitioner also argues that it has made out a claim that respondent's mark falsely suggest a connection with petitioner, and therefore, because a claim under Section 2(a) may be brought "at any time," petitioner is entitled to judgment on this ground. This ground was clearly never pleaded, nor do we find that it was tried. Petitioner did not even discuss such a ground in its main brief on the case. It cannot remedy its failure to plead a legally cognizable claim by this last-minute effort to assert a different ground.

Finally, we note that much effort and expense by the parties, and time by the Board, would have been avoided if, in response to the petitions to cancel, respondent had simply filed a motion to dismiss on the basis that Section 14(1) barred petitions to cancel these registrations on the ground of likelihood of confusion.

Decision: The petitions to cancel are dismissed.